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In re Application of
Roelof FEENSTRA, Johannes VAN DER HEIJDEN,
Cornelis KRUSE, Stephen K. LONG, Johannes MOS,
Gerben M. VISSER, Gustaaf VAN SCHARRENBURG,
and Gerrit P. TOOROP

Application No.: 09/831,149

PCT No.: PCT/EP99/08702

Int. Filing Date: 10 November 1999

Priority Date: 13 November 1998

Attorney Docket No.: 01975.0031

For: NEW PIPERAZINE AND PIPERIDINE
COMPOUNDS

DECISION REGARDING

SUBMISSION

UNDER 37 CFR 1.42

This decision is in response to applicants' submission of a declaration with the signature of an heir on behalf of a deceased inventor.

BACKGROUND

On 10 November 1999, applicants filed international application PCT/EP99/08702, which claims a priority date of 13 November 1998. A Demand electing the United States was filed on 22 May 2000. Accordingly, the 30 month period for complying with the requirements of 35 U.S.C. 371, expired at midnight on 13 May 2001.

On 07 May 2001, applicants timely filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee as required by 35 U.S.C. 371(c)(1), and a copy of the international application as filed as required by 35 U.S.C. 371(c)(2). However, no oath or declaration as required by 35 U.S.C. 371(c)(4) was filed.

On 22 June 2001, the United States Designated/Elected Office (PTO) mailed applicants a "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office" (DO/EO/US) (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 C.F.R. 1.497(a) and (b) and the surcharge for providing the oath or declaration later than 30 months from the priority date were required. Applicants were given a TWO (2) MONTH period from the mail date of the Notification to properly respond, with extensions of time obtainable under 37 C.F.R. 1.136(a).

On 14 August 2001, applicants submitted the instant declaration with the required surcharge under §1.492(e) for late filing. The declaration submitted states that joint inventor

Gerrit P. TOOROP is deceased, and is executed by Anne G. TOOROP as heiress of the deceased. Acceptance of this declaration is being considered under §§1.42 and 1.497.

DISCUSSION

37 C.F.R. §1.42, provides that:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, ... obtain the patent.

37 C.F.R. §1.497(b)(2), as amended effective September 8, 2000, provides that:

... If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

The identification of Anne G. Toorop as "heiress" is not sufficient to establish that she may make application on behalf of the deceased inventor, as it is not clear whether Ms. Toorop is the sole heir or whether other heirs are required to execute the declaration. Clarification is required. Applicants should also note that execution of the declaration by the heirs is only proper where an administrator or executor has not been appointed, and is not required to be appointed under the applicable law.

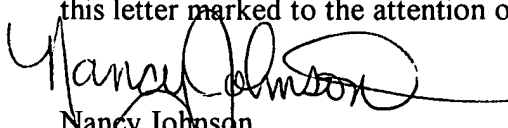
CONCLUSION

In view thereof, the declaration is not accepted under 37 CFR §§1.42 and 1.497. The submission is **DISMISSED**, without prejudice.

If reconsideration on the merits of this submission is desired, a proper response must be filed within **TWO MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42." No petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Should status under 37 CFR 1.42 not be successfully completed, the international application will be abandoned with respect to the United States of America.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C., 20231, with the contents of this letter marked to the attention of the PCT Legal Office.


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